

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

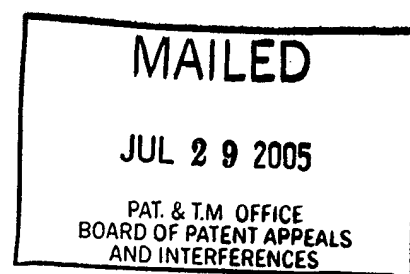
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROGER G. M. LUCASSEN and MICHEL M. SPRONK

Appeal No. 2005-1293
Application No. 09/453,480

ON BRIEF



Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4, 6, 7, 11 and 13 through 15, all of the claims remaining in the application. Claims 1 through 3, 5, 8 through 10 and 12 have been cancelled.

Appellants' invention relates to a cushioning conversion machine for converting sheet stock material into a cushioning dunnage product and to a method for controlling the formation of the dunnage product during a cutting operation to minimize machine

jams. Independent claims 1 and 11 are representative of the subject matter on appeal, and a copy of those claims can be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Huston, Sr. et al. (Huston)	5,213,867	May 25, 1993
Simmons	5,569,146	Oct. 29, 1996
Wilhelm et al. (Wilhelm)	5,943,844	Aug. 31, 1999

Claims 4, 6, 7, 11 and 13 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmons in view of Huston or Wilhelm.

Rather than reiterate the examiner's statement of the above-noted rejection and the conflicting viewpoints advanced by appellants and the examiner regarding the rejection, we refer to the examiner's answer (mailed September 30, 2004) for the reasoning in support of the rejection and to the brief (filed October 20, 2003) and reply brief (filed November 19, 2004) for appellants' arguments to the contrary.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art references, and the respective positions advanced by appellants and the examiner. As a consequence of our review, we have made the determination that the evidence relied upon by the examiner is not sufficient to support a conclusion of obviousness under 35 U.S.C. § 103 with respect to appellants' claims 4, 6, 7, 11 and 13 through 15 on appeal. Our reasoning for this determination follows.

As noted in the present specification (pages 3 and 11-12), one of the problems identified by appellants in prior art cushioning conversion machines, e.g., like that seen in Simmons, is that the cut end of the continuous dunnage strip (S) remaining in the machine may interfere with the return stroke of the moving blade unit (72, 73) by moving "behind" the cutting blade unit after it has reached its extended position and completed its cutting stroke (i.e., the position seen in Fig. 4 of Simmons) and thereby potentially cause a machine jam. Appellants note that such movement of the cut end of the dunnage strip can occur due to the nature of the dunnage strip (i.e., by relaxation and extension of the crumpled strip along its longitudinal axis). Appellants' solution to this problem is to provide a shutter (85) carried by the moving cutting blade (e.g., as shown in Figs. 4-7 of the present application) which is sized and positioned so as to

substantially block the strip path and prevent movement of the cut end of the dunnage strip (88) behind the cutting blade unit when the moving blade unit is in its extended position (application drawings, Fig. 5).

In rejecting claims 4, 6, 7, 11 and 13 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Simmons in view of Huston or Wilhelm, the examiner has found that Simmons shows a moving blade unit with a shutter means (73) that moves with the blade (72) to block the strip path in an extended position. The examiner points to Figure 5B2 of Simmons in support of that proposition and urges that this figure shows shutter means (73) which "prevents movement of a cut end from moving behind moving blade 72 since the cut end is under moving blade 72 as shown in figure 5B2" (answer, page 3). The examiner contends that the only feature missing in Simmons is that it does not show the shutter means (73) being flush with the blade as required in the claims on appeal. It is for this missing aspect of the claimed subject matter that the examiner turns to Huston and Wilhelm, contending that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Simmons with cutting means as taught by Huston or Wilhelm to make sure nothing interferes with the cutting blade.

Like appellants, we note that the examiner has provided no reasonable suggestion or motivation for attempting to modify the cushioning conversion machine of Simmons in light of the clearly distinct forms of cutting mechanisms shown in Huston and Wilhelm so as to arrive at the cushioning conversion machine and method as defined in the claims on appeal. Instead, as appellants have indicated in their brief and reply brief, the examiner has merely made certain unsupported findings with regard to the cutting blade unit of Simmons (reply brief, pages 3-5) and further proposed providing Simmons with a cutting blade unit like that taught in either Huston or Wilhelm with no basis in the applied prior art references to support any such modification of Simmons. As for the examiner's comments in the paragraph bridging pages 4-5 of the answer that the secondary references "show that the concept of cutting through a workpiece entirely to block the path is within the realm of one of ordinary skill in the art," we agree with appellants' assessment in the reply brief that the issue is not whether the person of ordinary skill in the art had the skill to provide a shutter as claimed to a blade like that in Simmons, but instead is whether the applied prior art provides such a person with any suggestion or motivation to do so. In this case, it does not.

In our view, the examiner's proposed modification of the apparatus and method of Simmons is based on impermissible hindsight derived from first having read appellants' disclosure and claims. As our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have determined that the teachings and suggestions found in Simmons and Huston or in Simmons and Wilhelm would not have made the subject matter as a whole of independent claims 4 and 11 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103. It follows that the examiner's rejection of dependent claims 6, 7 and 13 through 15 under 35 U.S.C. § 103(a) based on the teachings of Simmons and Huston or Wilhelm will likewise not be sustained.

REVERSED

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